

Application No. 10/005,959
Amendment "A" dated
Reply to Office Action mailed January 14, 2005

REMARKS

In a telephonic interview conducted January 3, 2005, the restriction requirement between groups I and II were proposed and an election was made to claims 1-29 and 54-57. By this paper, claims 30-53 and 58 have been cancelled, such that only claims 1-29 and 54 remain pending.

The first Office Action, mailed January 14, 2005, considered and rejected claims 1-29 and 54-57 in view of various combinations of art under 35 U.S.C. § 103.¹ It is noted that each of the §103 rejections relies at least in part on asserted teachings in Chamberlain (U.S. Patent No. 6,438,749) and on the assertion that Chamberlain actually qualifies as prior art. Applicants respectfully submit, however, that Chamberlain does not qualify as prior art for 35 U.S.C. §103 rejections, as applied to the present application, according to 35 U.S.C. §103(c). In particular, Chamberlain was commonly assigned to Microsoft Corporation, the assignee of the present application, at the time of the invention. Furthermore, inasmuch as Chamberlain could only qualify as 102(e) art, since it issued after the present application was filed, it cannot be used in a 35 U.S.C. § 103 rejection of the present application. Applicants also submit that Chen (U.S. Patent No. 6,360,364) is disqualified as prior art, for §103 rejections, for at least the same reasons: (commonly assigned to Microsoft Corporation, the assignee of the present application, at the time of the invention, and issuing after the filing of the present application).

¹ The last action stated that claims 1-7, 11-29 and 64-67 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kelly, ("Gain Control of Application Setup and Maintenance with the New Windows Installer"), in view of Chamberlain (U.S. Patent No. 6,438,749). Applicants note, however, that claims 64-67 do not exist. Accordingly, it is presumed that the Examiner intended to instead reject claims 54-57, as suggested by subsequent references to these claims. Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kelly and Chamberlain, and further in view of Chen (U.S. Patent No. 6,360,364). Claims 9 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kelly and Chamberlain and further in view of Ballantyne (U.S. Patent No. 6,687,873). Inasmuch as it is not necessary, the asserted teachings of the prior art is not being challenged at this time. Nevertheless, it will be appreciated that Applicants reserve the right to challenge the asserted prior art teachings at any appropriate time, should it arise, such that this paper should not be construed as acquiescing in any way to the prior art teachings of the cited art.

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Accordingly, inasmuch as each of the substantive rejections to the claims relies at least in part on Chamberlain, and in some cases on both Chamberlain and Chen, applicants respectfully submit that all of the §103 rejections should now be withdrawn.

The remaining rejections rely on technicalities and informalities which are addressed and resolved below. In particular, the objection to claim 23 regarding the inadvertent duplication of the term "installation" has been resolved by deleting an instance of this term, as suggested.

Claim 17 has also been amended to resolve the rejections to claims 17-19 for indefiniteness under 35 U.S.C. § 112. In particular, the term "one other module" has been replaced with "one module", by deleting the term "other".

Objections were also made to the drawings, which Applicants respectfully traverse. In particular, with regard to the rejections under 37 CFR 1.83(a), requiring all features to be shown in the drawings, Applicants respectfully submit that the features of claims 7-8, 10-11 and 20-22 are shown in the drawings. In particular, Figure 4 shows the features of accessing versions of files to be installed (element 401)(which can include accessing compressed version and decompressing it (claims 7-8)); accessing instructions (element 404)(wherein the instructions can include XML instructions and instructions to extract a compressed version of a file as described in the application (claims 10-11)), and constructing a rollback document (element 406) (which as described in the application can include backing up an original version according to a pre-installation state (claims 20-22)).

Accordingly, these objections to the drawings should be withdrawn.

The last objection at issue involves the asserted need to designate Figures 1 and 2 as - Prior Art-. Applicants respectfully submit, however, that this is not necessary and should not be done inasmuch as Figures 1 and 2 illustrate aspects of the invention which Applicants consider to

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be part of the unique and novel features of the invention. Applicants do not, therefore, agree that Figures 1 and 2 are prior art. Accordingly, these Figures should not be labeled as prior art.

In view of the foregoing, Applicants respectfully submit that all of the rejections and objections of record have been resolved, such that all of the pending claims (1-29 and 54-57) and all of the drawings should be allowed.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 28 day of January, 2005.

Respectfully submitted,



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